

Remarks

Applicants thank the Examiner for acknowledging and entering the Applicants' election with traverse of Group I and the compound I-1-1 in the reply filed on June 9, 2008.

Reconsideration of this Application is respectfully requested. Claims 1-8, 10, 12-15 and 17 are pending in the application, with claims 1 and 12 being the independent claims.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Priority

Applicants will forward an English language copy of the foreign document 10337496.5, separately.

Restriction Requirement

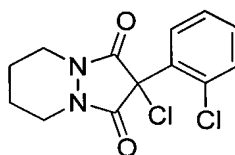
Applicants preserve the right to have non-elected dependent process claims rejoined and allowed, pursuant to 37 C.F.R. § 1.104. *See Manual of Patent Examining Procedure, 8th edition, § 821.04(b) (September 2007).*

Rejections under 35 U.S.C. § 103

The rejection of claims 1-5, 7 and 10 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,180,568 B1 ("Takahashi") in view of U.S. Patent Application Publication No. 2003/0096806 A1 ("Lieb") and U.S. Patent Application Publication No. 2006/0160703 A1, the English language equivalent of the cited

International Application Publication, WO 03/045957 A1 ("Fischer") is respectfully traversed. The Office is of the opinion that it would have been obvious to modify Takahashi in view of Lieb and Fischer to arrive at the claimed invention.

It is respectfully submitted that the Office has not established a *prima facie* case of obviousness. The Office has identified a compound in Takahashi with the structure illustrated below ("Takahashi compound") and states that it can be used as a component of a miticide, insecticide or herbicide. (*Office Action*, page 4).



Takahashi Compound (col. 9, table 5, cpd. 40)

Lieb describes that cyclic ketoenols, which is a different class of compounds than the claimed compounds, can be mixed with extenders or surfactants or a mixture thereof. Lieb further discloses that its compounds can be used as herbicides or pesticides. Fischer discloses that ketolactams and ketolactones, which are different classes of compounds than the claimed compounds, can be used as pesticides, microbicides or herbicides.

It is respectfully argued that the Office has not provided a reason why a person having ordinary skill in the art would have considered modification of the Takahashi compound by replacing the chlorophenyl group with a naphthyl derivative, as encompassed by Applicants' invention. Given the unpredictability of the art, the art does not teach that such a modification would be an identifiable, predictable solution.

Furthermore, the Office has not established that a person of ordinary skill would have had a reasonable expectation that the modification of the Takahashi compound by replacing the chlorophenyl group with a naphthyl derivative would result in a genus of

compounds with herbicidal, pesticidal and/or microbicidal activity. In particular, the compounds of Lieb and Fischer do not share the core structure of the claimed compounds. Neither Lieb nor Fischer, therefore, cure the deficiencies of Takahashi, particularly considering the unpredictability of this art. The Office has used impermissible hindsight to conclude that the compounds of the present invention are rendered obvious over the cited art.

As further evidence of the nonobviousness of claims 1-5, 7, and 10 of the current application over Takahashi in view of Lieb and Fischer, Applicants provide herewith as Exhibit A, a Declaration under 37 C.F.R. § 1.132 by Dr. Wolfgang Thielert ("the Thielert Declaration"). The experimental results described in the Thielert Declaration illustrate that the claimed compounds are superior to the compounds described in Fischer. (The Thielert Declaration, pages 1-3). Specifically, an illustrative compound of the present invention had 100% efficacy in the prevention of galls on roots, whereas the Fischer compound has 50% efficacy as compared to untreated plants. *Id.* at 2. The concentration of the compounds was identical. The data, therefore, shows that when an exemplary compound of the present invention is compared against an exemplary compound of Fisher in the same experiment, the compound of the present invention showed superior nematocidal activity. *Id.*

In addition, Applicants submit a Declaration under 37 C.F.R. § 1.132 by Dr. Heinz Kehne ("the Kehne Declaration") (Exhibit B) where the experimental results described therein illustrate that the claimed compounds have superior overall herbicidal activity when used to treat various plants. (the Kehne Declaration, pages 2-5). Namely, the data shows that when three exemplary compounds of the present invention are

compared against an exemplary compound of Fisher under the same experimental conditions, the compounds of the present invention showed superior herbicidal activity on most of the plants tested. *Id.* at 2-4.

In view of the above arguments, it is respectfully requested that the Office withdrawal the rejection under 35 U.S.C. § 103(a).

Double Patenting Rejection

The rejection of claims 12-14 on the basis of nonstatutory obviousness-type double patenting over claims 10, 14, and 15 of copending U.S. Pat. Appl. No. 10/542,513 ("the '513 application") is respectfully traversed. Solely to expedite prosecution and not in acquiescence to the Office's rejection, Applicants files a Terminal Disclaimer over the '513 application herewith. Therefore, Applicants submit this rejection has been rendered moot.

Accordingly, Applicants respectfully request that the preceding rejection be withdrawn.

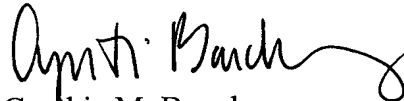
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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